REMARKS

The Office Action dated August 5, 2004 has been reviewed and carefully considered. The Examiner's indication of allowable subject matter for claims 3, 6, 7, 12 and 13 is appreciated. Claims 3-6 and 10-12 have been redrafted into independent form. Claims 1-15 remain pending, of which the independent claims are 1, 3-6, 8 and 10-12. Claims 1-6 and 8-12 have been amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

Claims 1 and 8 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,870,146 to Zhu.

Claim 1, as amended, recites a "said filtering step using a recursive filter." Zhu fails to disclose or suggest use of a recursive filter. For at least this reason, Zhu fails to anticipate the present invention as recited in claim 1. Nor would it have been obvious to modify Zhu for the claimed feature. Support for the amendment of claim 1 is found in the present specification (e.g. [0012]).

Claim 8 is an apparatus claim based on method claim 1, recites a "recursive filter circuit," and is deemed to distinguish patentably over Zhu for at least the same reason set forth above with regard to claim 1.

Claims 2, 5, 9, 11, 14 and 15 stand rejected under 35 U.S.C. 103(a) as unpatentable over Zhu.

Claim 2 depends from claim 1, and is deemed to be patentable over Zhu for at least the same reasons.

Claim 9 depends from claim 8, and is deemed to be patentable over Zhu for at least the same reasons.

Claim 5 recites, "comprising an inverse filtering sub-step." Zhu fails to disclose or suggest this feature.

Item 4 of the Office Action acknowledges that Zhu does not disclose this feature, but suggests that it would have been obvious. Item 4 of the Office Action suggests that an inverse filter is known, and that the skilled practitioner would have been motivated to "enhance prediction process."

Firstly, non-obvious inventions are generally composed of known elements.

Secondly, although the skilled practitioner is motivate to "enhance" whatever he or she works on, this does not explain why it would have been obvious to the practitioner of ordinary skill in the art to modify Zhu by adding in an inverse filter circuit. It would not have been obvious, except through impermissible hindsight gained from reviewing the present invention disclosure.

As set forth above, Zhu fails to anticipate or render obvious the invention as recited in claim 5. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 11 recites "an inverse filter circuit," and is likewise deemed to be patentable over Zhu.

Claims 14 and 15 depend from claim 1, and are deemed to distinguish patentably over Zhu for at least the same reasons set forth above with regard to claim 1.

The applicants traverse the Official Notice that a set-top box contains a transcoder.

Claims 4 and 10 stand rejected under 35 U.S.C. 103(a) as unpatentable over Zhu in view of U.S. Patent No. 6,178,205 to Cheung et al. ("Cheung").

Claim 4 recites, "the filtering step is a spatial filtering step for receiving the first transformed signal and for producing a filtered transformed signal, said filtered transformed signal and the transformed motion-compensated signal being delivered to the quantizing sub-step."

The Office Action suggests that the "first transformed signal" of present claim 4 corresponds to the input former 42, but the latter is a device and the former is a signal.

Presumably, the Office Action intends to call Zhu quantized input signal 124 the "first transformed signal" of present claim 4, based on the first element of base claim 1. The Office Action is calling Zhu prediction signal 59 the "transformed motion-compensated signal" of the present claim 4.

Also, the Office Action is presumably referring to Zhu quantizer 78 as corresponding to the "quantizing sub-step" of present claim 1.

Again, although the Office Action does not specify, it presumably deems the "spatial filtering step" of present claim 4 to correspond to Zhu filter 136.

Following the above reasoning, the "filtered transformed signal" resides between the Zhu filter 136 and the Zhu quantizer 78. Therefore, presumably, the "filtered transformed signal" is "delivered to the quantizing sub-step."

However, it is unclear how it fairly could be said that the "transformed motion-compensated signal," presumably Zhu prediction signal 59 is "delivered to the quantizing sub-step." The only apparent route is through the filter 136.

This would suggest that a signal traversing that path, i.e., through the filter, should be called a "filtered . . ."

By contrast, present claim 4 calls the signal the "transformed motion-compensated signal," without any suggestion of filtering.

For at least this reason, Zhu fails to disclose or suggest the invention as recited in claim 4. Cheung fails to make up for this deficiency in Zhu. Zhu/Cheung, for at least the above reasons, fails to render obvious the present invention as recited in claim 4. Reconsideration and withdrawal of the rejection is respectfully requested.

As to claim 10, it is an apparatus claim based on method claim 4 and recites the same distinguishing language. Accordingly, claim 10 is deemed to be patentable over Zhu/Cheung.

As to the other rejected claims, each depends from a respective base claim that has been shown to be patentable, and is likewise patentable at least due to its dependency.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Enclosed is a check in payment of 6 independent claims added in excess of three. The amount of the check is 6 x $88 = $528.00.

Respectfully submitted,

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